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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,876	07/11/2001	William S. Somers	37174/9	9624
26161	7590	05/04/2006	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			PAK, MICHAEL D	
			ART UNIT	PAPER NUMBER
			1646	
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**GROUP 1600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/903,876  
Filing Date: July 11, 2001  
Appellant(s): SOMERS ET AL.

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Allyson R. Hatton  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed November 4, 2005 appealing from the Office action mailed February 8, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is substantially correct. The changes are as follows.

The rejection of claims 8, 12 and 13 under 35 USC 101 because the claimed invention is directed to non-statutory subject matter is withdrawn.

The rejection of claims 7-13, 16 and 17 under 35 USC 112 paragraph one because the claimed invention is directed to new matter is withdrawn.

The rejection of claims 7-13, 16 and 17 under 35 USC 103 because the claimed invention is directed to obvious invention is withdrawn.

Claims 8, 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows.

The rejection of claims 8, 12 and 13 under 35 USC 101 because the claimed invention is directed to non-statutory subject matter is withdrawn.

The rejection of claims 7-13, 16 and 17 under 35 USC 112 paragraph one because the claimed invention is directed to new matter is withdrawn.

The rejection of claims 7-13, 16 and 17 under 35 USC 103 because the claimed invention is directed to obvious invention is withdrawn.

Claims 7, 9-11, 16 and 17 remains rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Trilateral Project WM4 Comparative Studies in New Technologies: Report on Comparative Study on Protein 3-Dimensional (3-D) Structure Related Claims.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 7, 9-11, 16 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims are drawn to a method of using computer algorithm which is non statutory because claims are drawn to abstract ideas without practical application that is tangible.

**(10) Response to Argument**

Response to arguments regarding rejection of claims 7, 9-11, 16 and 17 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Appellants argue that the subject matter covered by the claims satisfies the utility requirement because of the trilateral report indicates that screening method have utility. However, the rejection is based upon 35 USC 101 rejection because the claims are directed to non-statutory subject matter and not because a rejection based upon lack of the utility requirements. Appellants arguments do not address the 35 USC 101 rejection based upon non-statutory subject matter. Rather appellants argue support for utility requirement based upon the trilateral report. The arguments regarding the support for utility requirement because of the trilateral report is a different issue from the rejection of

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claims because the invention is directed to non-statutory subject matter. The rejected claims are directed to non-statutory subject matter because the methods do not require a tangible step and the method is performed in the abstract such as a computer visualization of the crystal structure. Unlike the rejected claims, claims 8, 12 and 13 include the term "contacting the agent" which can be a computer simulation of a crystal structure of estrogen receptor contacting with the structure of the agent ligand. Although methods of claims 8, 12 and 13 may be performed entirely in a computer simulation of the crystal structure, the act of "contacting" provides the interaction of computer simulations. However, the rejected claims are entirely drawn to providing crystal structure in the abstract whether it is in the computer, paper or other forms of providing an abstract crystal structure.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Pak



**MICHAEL PAK  
PRIMARY EXAMINER**

Conferees:

Brenda Brumback

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Ardin Marschel

*Ardin H. Marschel 4/15/06*  
**ARDIN H. MARSCHEL**  
**SUPERVISORY PATENT EXAMINER**

*Brenda Brumback*  
**BRENDA BRUMBACK**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**